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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,843	09/17/2003	Shigekazu Zen	Q77444	2852

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SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

PAK, JOHN D

ART UNIT PAPER NUMBER

1616

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/663,843

Applicant(s)

ZEN, SHIGEKAZU

Examiner

JOHN PAK

Art Unit

1616

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 23 August 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): NONE.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: _____

Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE


8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____


JOHN PAK
PRIMARY EXAMINER
GROUP 1600

Continuation of 11. does NOT place the application in condition for allowance because of the following reasons:

Applicant argues in the 8/23/2005 after-final reply that the final rejection was premature. Applicant is quite mistaken. The standard for a proper final rejection that applies a new ground of rejection with new prior art reference(s) is whether said new ground of rejection was necessitated by applicant's amendment, not whether said ground of rejection could hypothetically have been made in an earlier Office action. The Examiner is not required to reject the claims every which way, in countless number of ways over countless number of different prior art references, just to cover all possibilities and permutations of future amendments. The correct standard is, whether or not applicant's amendments necessitated the new ground of rejection which applies new prior art references.

Here, in response to the first Office action (5/26/2004), applicant amended the claims so that the previous ground of rejection had to be withdrawn. The cited art in the first Office action was U.S. Patent No. 5,846,997, which discloses benzyl acetate. In response to the first Office action, applicant amended the claims by cancelling benzyl acetate and other esters of the formula RCOO-X-Ar. So the Examiner had to withdraw the ground of rejection made in the first Office action and apply new art to address the claim amendments. This is a classic example of a proper new ground of rejection which is necessitated by applicant's amendment. The finality of the subsequent Office action (2/23/2005) was therefore proper.

As to substantive issues, applicant's arguments are also not persuasive. Applicant argues that applicant's invention is "a low-irritant pesticidal emulsifiable concentrate which can be used as an emulsion which is superior in emulsion stability after diluting with water." First, low irritant effect is not even claimed. The Examiner is not required to meet unclaimed features. Second, Schmitt et al. clearly disclose pesticidal emulsifiable concentrates (see pages 2-3 of the 2/23/2005 Office action). Schmitt et al. disclose pesticides, anionic surface active agent, emulsion, and a high concentration amount that qualifies as a concentrate. What more does applicant require for a pesticidal emulsifiable concentrate? Third, "superior emulsion stability" is for applicant to establish through objective evidence. To date, applicant has not established through objective evidence that applicant's emulsion is unexpectedly superior in emulsion stability in comparison to Schmitt's emulsion.

Applicant argues that "Schmitt does not disclose a pesticidal emulsifiable concentrate comprising pyrethroids" and "Schmitt does not disclose a pesticidal emulsifiable concentrate comprising the additive compounds." Applicant is in error on both accounts. Claim 1 by Schmitt et al. explicitly discloses a composition that contains a solvent, emulsifier, and one or more of various pyrethroids such as permethrin, cypermethrin, allethrin, alphenmethrin, bioresmethrin, byfenthrin, cydoprothrin, cyfluthrin, decamethrin, cyhalothrin, and deltamethrin. Schmitt's claim 1 clearly and explicitly encompasses such pyrethroids. How can applicant ignore the recitation of so many pyrethroids in Schmitt's claim 1? Is the ordinary skilled artisan somehow instructed to NOT select the pyrethroids that are explicitly recited in the claim? Has the rule of claim construction been changed for a U.S. Patent claim? The full scope of Schmitt et al. would have been within the skill of the ordinary skilled artisan, who would have been motivated to select such pyrethroids for further protection of wood, as fully discussed on pages 3-4 of the Final Office action (2/23/2005). As for the "additive compounds," it is noted that Schmitt's claim 1 requires a solvent, and butyl benzoate is explicitly taught as a preferred solvent (column 3, lines 11-12). Use of butyl benzoate as the solvent in Schmitt's claim 1 is therefore amply suggested. It is noted that butyl benzoate is specifically claimed by applicant (claim 5).

Applicant also argues that the Examiner has not provided reasoning why one skilled in the art would select the claimed combination of components from the numerous combinations disclosed in Schmitt. Applicant is again in error. On pages 3-4 of the Final Office action, the Examiner stated that butyl benzoate is the preferred solvent, so its selection is suggested; and the ordinary skilled artisan would have been motivated to include pyrethroids such as cypermethrin and permethrin because of the activity such insecticides are known to have against wood destroying termites. Since Schmitt's composition is for protecting sawn timber, additional protection against wood-destroying termites is sufficient motivation to select such pyrethroids.

All of applicant's arguments are thereby found unpersuasive, and the outstanding ground of rejection must be maintained.